

### REMARKS

Applicants have amended the claims in order to make it clear that the image layers have at least one image thereon and that the fold line of the integral composite product extends across the image layers on the composite product. While it is believed that this language was inherent in the previous description, Applicants have amended the claims to clearly point out the structure of the present invention.

The Examiner has finally rejected claims 1, 2, 4-9, 29-33 and 44-47 under 35 USC § 103(a) as being unpatentable over Applebaum et al. in view of Robertson et al. for the reasons set forth in paragraph 2. The Examiner has also finally rejected claim 3 under 35 USC § 103(a) as being unpatentable over Applebaum et al. in view of Robertson et al. and further in view of Douglas. The Examiner also rejected claim 34 under 35 USC § 103(a) as being unpatentable over Applebaum in view of Robertson and further in view of Hansen for reasons set forth in paragraph 4.

The Examiner, in all the rejections, has rejected the independent claims primarily on US Patent 4,183,162 to Applebaum et al.

Independent claim 1 is directed to a dual sided integral composite product having a first support substrate having a separate image layer thereon having at least one image and a second support substrate having a separate image layer thereon also having at least one image. The first and second substrates are secured together to form a dual sided integral composite product. The product has a fold line about which the integral composite image product may be folded. Claim 1 further sets forth that the fold line extends across the separate image layers.

Applicant respectfully submit that the Applebaum et al. reference is directed to an invention totally apart and distinct from the present invention. Applebaum is directed to an album wherein separate individual prints (panels) are secured to hinge members 8, 10, 38 or 40. The reason for this is that the Applebaum reference is looking for a better procedure to print photographs in a panoramic manner without folding it and causing damage. See column 1, lines 39-42 and lines 45-46. Thus, it is clear that the Applebaum reference teaches away from the present invention in that it is seeking to avoid providing fold lines

across images as set forth in independent claim 1. As further set forth in the Applebaum reference, see column 1, lines 35-36 and column 5, lines 55-56, is directed and discloses the cutting of the print. The print is cut and then secured to the album by hinges. The Examiner refers to column 5, lines 25-30 as indicated in that the image may be provided on both sides of the hinge. However, this is not directed to an integral composite image having a fold line across the image area as taught and claimed by Applicant. As previously noted, Applebaum teaches away from folding of the image and in fact teaches the providing of cutting the image and securing it together through the use of hinges.

The Examiner cites the Robertson et al. reference for illustrating hinge/fold line on the image product. In this regard as stated at column 3, lines 42-45, side by side strips of opaque, imageable film 168 in reverse printable backlit formulation 172 are preferably extrusion-coated or coextruded on top of the film 164. Therefore, these print areas are not integral products. It can also be seen that printing occurs only on one side, in particular, on imageable film 168 and formulation 172. Thus, when the product is folded as illustrated in Figure 7, the reverse graphics will be seen through the film in the correct readable orientation. Applicant respectfully submit that the Robertson et al. patent fails to teach or suggest the providing of a fold line on the integral image product as taught and claimed by Applicant. Furthermore, Applicant respectfully submit that it would not be obvious to combine the references as suggested by the Examiner. As set forth *In re Lee*, 61 USPQ 2d 1430 CAFC (2002) when patentability turns on a question of obviousness, the search for and analysis of prior art includes evidence relevant to the finding of whether there is a teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. The central question is whether there is reason to combine the references. The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. A showing of a suggestion, teaching or motivation to combine the prior art reference is an essential component of an obvious holding. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant. Teaching of the reference can be combined only if there is some suggestion or incentive to do so. The Examiner can satisfy the burden of showing obviousness or the combination only by showing some objective

teaching in the prior art or that knowledge generally available to one of ordinary skill that would lead the individual to combine the relevant teaching of the references. See *In re Lee* 61 USPQ at 1434.

In the present case, the Applebaum reference clearly does not teach or suggest the invention, in fact teaches away from providing a single unitary object. Thus, as previously noted, neither the Robertson or Applebaum references teach or suggest the invention. Thus, Applicant respectfully submit that there must be some motivation, teaching or suggestion that would lead one to combine one reference with the other. As previously discussed, the Applebaum reference teaches away from the combination. Further, as previously explained, even if the two were combined, they would not provide the structure of the present invention. Similarly, claims 29, 44, 45 and 47 are patentability distinct for the same reasons.

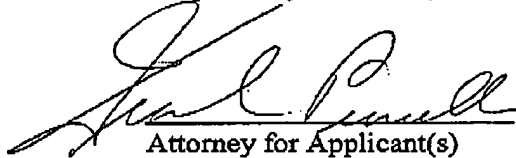
The Examiner, in the Official Action, cited *Howard v. Detroit Stove Works* for the proposition that making two pieces by one is not patentable. In the present invention, Applicants respectfully submit that the *Howard v. Detroit Stove Works* case is not relevant to the present inquiry. First, Applebaum does not teach this structure either individually or in combination. The Applebaum reference teaches individual prints that are secured to the album by hinges which are secured to the spine. As previously noted, this reference teaches away from providing a single unitary image product. Thus, Applicant respectfully submit that the *Howard v. Detroit Stove Works* case is of little relevance to the present invention.

With regard to limitations not being important to the claim. Claim 29 specifically discloses a composite cover and at least one leaf and in the last line, states that attaching member for securing the at least one leaf to the cover. Thus, it is clear that all of the elements are incorporated in the claim. Further, claim 29 is patentably distinct for the same reasons discussed with respect to independent claim 1.

Claims 3 and 34 depend at least ultimately upon independent claims which have been shown to be patentably distinct. Accordingly, these claims are patentably distinct for the same reasons previously discussed.

In view of the foregoing, Applicant respectfully submit that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



Attorney for Applicant(s)  
Registration No. 27,370

Frank Pincelli/phw  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646